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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,582	01/04/2001	Hiroyuki Matsushima	201510US2	2026
22850	7590	04/21/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			MOONEYHAM, JANICE A	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/753,582

Applicant(s)

MATSUSHIMA, HIROYUKI

Examiner

Jan Mooneyham

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This is in response to the communication filed on January 4, 2001. Claims 1-31 are currently pending in this application.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

3. The information disclosure statements (IDS) submitted on January 4, 2001, December 1, 2003 and February 11, 2003 are being considered by the examiner.

Specification

4. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and **should include that which is new in the art to which the invention pertains.** If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

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Extensive mechanical and design details of apparatus should not be given.

- From reading the abstract, the Examiner is unable to ascertain the new art to which the invention pertains. Appropriate correction is required.
- A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.
- 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: There are numerous grammatical errors through out the application. For example, on page 1, line 9, the applicant states that "[t]he related to lending include reservation of the information device." What is the applicant trying to say? Throughout the specification and claims, there are numerous problems such as this. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 1, the term "can be connected" renders the claim indefinite.

What does the applicant mean by the word "judges" in line 13?

Claims 1-31 are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

The applicant uses abbreviations through out the specifications and the claims without defining the abbreviations, for example, IC. I/F. The applicant is required to go through the application and make the appropriate corrections.

Claim 7 recites the limitation "to the small size information device" in line 14. There is insufficient antecedent basis for this limitation in the claim.

In Claim 8, the applicant identifies an image transmission method designation unit. It is unclear what the applicant is trying to claim. Furthermore, Claim 8 is for a system, not a method.

Claim 26 appears to be an independent claim.

Claim 27, reads on claim 26. What is "rest of reserved time?"

Claim 28 identifies a method but fails to identify method steps.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claim 1-5, 13-17 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foladare et al. (US Patent 5,914,472) (hereinafter referred to as Foladare).**

Referring to Claims 1, 13 and 31:

Foladare discloses a lending management system and medium comprising:

a client terminal connected to a network (central computer contact means, card reading device (200), col. 4, lines 11-27, col. 6, line 58 – col. 7, line 22);

a server terminal (central computer, (204)) connected to said network and to which a small sized information device (ancillary transaction credit card) is connected using a cable or radio waves (col. 4, lines 58-63), said server terminal receives information related to reservation from said client terminal (Fig. 1, col. 4, lines 19-27), judges whether reservation for lending (ancillary transaction card)said small information device can be registered or not in accordance with the received information (col. 4, lines 23-57), and if it is judged that the reservation can be registered, registers the reservation and transmits an information to said client terminal which indicates that the reservation has been registered (col. 3, line 65 thru col. 4, line 57, col. 5, lines 9-35).

Foladare does not explicitly disclose that the information is in regard to a reservation. However, this is non-functional descriptive material since the information does not reconfigure the system. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703, F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d. 1579, 32 USPQ2d 1031 (Fed Cir. 1994)

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the information be reservation information because the type data

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does not functionally relate to the structure claimed and thus does not patentably distinguish the claimed invention.

Foladare does not disclose a lending management system wherein the information is a reservation for a digital camera. However, the system disclosed in Foladare discloses a lending management system with the same problem as the applicant' and the same solution. The only difference is that Foladare discloses a smart card having users rights whereas the applicant is disclosing a digital camera having users rights.

Referring to Claims 2 and 14:

Foladare discloses a lending management system wherein the server terminal further comprises a user certification unit which authenticates a user's access right (Figs. 1-3, col. 3, lines 2- 42).

Referring to Claims 3 and 15:

Foladare discloses a lending management system wherein said user certification unit carries out the user certification by checking a user identification and password (Fig. 1, (101, 102) col. 2, lines 48-53).

Referring to Claims 4 and 16:

Foladare discloses a lending management system wherein said user certification unit is provided with a magnetic card reader (Fig. 1 (101, col. 4, lines 11-27).

Referring to Claims 5 and 17:

Foladare discloses a lending management system wherein the user certification unit is provided a card reader (Fig. 1 (101), col. 4, lines 11-27).

7. Claims 8-12, 20-24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foladare et al. (US Patent No. 5, 914, 472) (hereinafter referred to as Foladare) in view of Shiota et. al (US 6,657, 660) (hereinafter referred to as Shiota) .

Regarding Claims 8 and 20:

Foladare discloses a lending management system. Foladare does not disclose a system wherein the client terminal further comprises an image transmission designating unit for transmitting an input image data and a server terminal transmitting the input image data

However, Shiota discloses disclose a system wherein the client terminal further comprises an image transmission designating unit for transmitting an input image data, and a server terminal transmitt the input image data (Fig. 1)

It would have been obvious to incorporate the teachings of Shiota into the disclosure of Foladare so that pictures recorded by a digital camera can be more easily stored and utilized bu the user.

Referring to Claims 9-12 and 21-24:

Shiota discloses system wherein the image transmission comprises an electronic computer originated mail, wherein the image transmission employs a FTP (file transfer protocol) in a TCP/IP, wherein the image transmission comprises a file transfer command in a HTTP and further comprising a printing unit for printing the input image data (Fig. 1).

Furthermore, the examiner takes Official Notice that it is old and well known to employ FTP in a TCP/IP to transfer files, that HTTP file transfer commands are old and well known, and printing units for printing input image data are old and well known.

Referring to Claim 25:

Foladare discloses a lending management system. Foladare does not disclose a lending management system wherein the input image data is stored in the WWW server.

However, Shiota discloses a lending management system wherein the input image data is stored in the WWW server (Fig. 1).

It would have been obvious to incorporate the teachings of Shiota into the disclosure of Foladare so that pictures recorded by a digital camera can be more easily stored and utilized.

8. **Claims 6, 7, 18, 19 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foladore et al (US 5,914,472) in view of Steinberg et al (US 6,433,818) (hereinafter referred to as Steinberg).**

Referring to Claims 6 and 18:

Foladore discloses a lending management system. Foladore does not disclose a lending management system wherein the user certification unit includes a fingerprint input unit.

However, Steinberg discloses a user certification unit including a fingerprint input unit (Fig. 7, col. 2, lines 3-6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate into the system of Foladore the teachings of Steinberg since it allows the lender the ability to restrict the use of the camera to only authorized users and provides the camera with a theft protection system.

Regarding Claims 7 and 19:

Steinberg further discloses a lending management system wherein the device is provided with a lock switching unit for switching operation possible/operation impossible in accordance with an input signal (col. 2, lines 3-37)

wherein said server terminal transmits a lock release signal (col. 2, lines 20-29, Fig. 1)

Regarding Claim 28:

Foladore discloses method comprising:

authenticating the user's identification and password ((Fig. 1, (101, 102) col. 2, lines 48-53).

Foladore does not disclose:

confirming the reservation

releasing the lock of the device.

However, Steinberg discloses:

confirming the reservation (rental) (col. 1, line 66 thru col. 2, line 2, col. 2, lines 39-45, Fig. 7)

releasing the lock of the device (col. 2, lines 3-37) .

It would have been obvious to incorporate into the method of Foladore the teachings of Steinberg since it allows for the rental of a digital camera wherein the use is restricted to encourage the return of the camera.

9. Claims 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foladare and Steinberg as applied to claim 28 above, and further in view of Shiota..

Regarding Claim 29:

Neither Foladore nor Steinberg disclose transmitting an image. However, Shiota discloses transmitting an image (Figs. 1-3).

It would have been obvious to one of ordinary skill in the art to incorporate the teachings of Shiota into the method of Foladore and Steinberg because it allows for the storage and utilization of pictures taken with a rented digital camera.

Regarding Claim 30:

Shiota further discloses a method wherein the transmission comprises any one of an email, the FTP in the TCP/IP, or the command transfer of the HTTP (Fig. 1.) Furthermore, transferring images by email, TCP/IP and HTTP is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made since it is common every day practice to transmit images this way.

10. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knolls (US Patent 6,606,602) (hereinafter referred to as Knolls).

Referring to Claims 26 and 27:

Knolls discloses a device (for use with digital cameras, col. 5, lines 46-63) comprising a lock switching unit for switching operation possible/operation impossible (col. 9, lines 29-44) and a device comprising a display unit (Figs. 3a-3g), wherein the device transmits a lock signal to said lock switching unit when the reserved time is over (col. 9, lines 29-44, counter/timer)

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The fact that the display unit is for displaying rest of a reserved time is directed to an intended use of the display unit and does not result in structural or functional differences with respect to prior art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

QuikBiz discloses digital camera rentals.

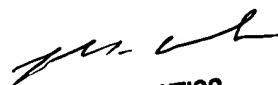
WO 01/67405 discloses a digital camera rental system for renting the camera and outputting the photograph data with a sensor.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan Mooneyham whose telephone number is (703) 305-8554. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM


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